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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,206	12/18/1998	DAVID WILLIAM ROTH	B2745.0025/P0025	1079
7590 03/19/2008 BEH INVESTMENTS LLC 1652 48TH STREET BROOKLYN, NY 11204				
EXAMINER VAN BRAMER, JOHN W				
ART UNIT 3622		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/216,206

Applicant(s)

ROTH ET AL.

Examiner

John Van Bramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49, 50 and 62-232 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49, 50 and 62-232 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 30507 and 122007.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Inventorship

1. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a). Based upon the Applicant's remarks dated December 4, 2007, Mr. Salisbury can be deemed a joint inventor at least as to claims 34 (cancelled), 46 (cancelled), 59 (cancelled), and 231 (pending) and 232 (pending). The examiner notes that the phrase "at least as to" does not satisfy the obligation set forth by 37 CFR 1.56.

Priority

2. The Applicant's is attempting to claim the benefit of a prior-filed application. However, the applicant has admitted Inventorship issues that affect not only the instant application but the application for which priority is being claimed in the Applicant's Arguments/Remarks Made in an Amendment dated December 4, 2007. While the examiner is expected to presume that the subject matter of the various claims in an application were commonly owned at the time of an applicants filing, this presumption is only made in the absence of evidence to the contrary. In the

Applicant's remarks, it is admitted that it has recently come to their attention that the joint inventors are not common owners of the entire invention. Therefore, it is impossible for the examiner to make a determination regarding the priority dates and which inventor is to be assigned to each claim in the instant application and in prior filed application 08/787,979. Furthermore, the information disclosed may materially affect all previously filed and granted petition regarding inventorship of the instant application. As such, the applicant is advised to refile said petitions.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 49,50, 62-65, 114-118, 166-170 and 218 are rejected under 35 U.S.C. 102(b) as being anticipated by Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claim 49: Yager discloses a computerized method for determining an advertisement in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer network an indication of the advertising opportunity.
(Page 383, Paragraph 2)
- b. In response to receiving the indication: selecting in a computer the advertisement from among a plurality of advertisements associated with bids submitted in real-time by the computer on behalf of advertisers desiring to fulfill the advertising opportunity. (Page 383, Paragraph 2)

Claim 50: Yager discloses the method of claim 49, wherein the indication of the advertising opportunity is initiated by the browser sending a reference in the web page. (Page 382, Paragraph 6)

Claim 218: Yager discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid being associated with indicating a monetary amount the each bidding advertiser is willing to pay if an advertisement associated with each bidding advertiser is selected and a specific event occurs. (Page 382, Paragraph 3)

Claims 62: Yager discloses a method implemented in a computer system comprising of one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, the each advertising opportunity being an opportunity to

serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, whereby the each set of bidding parameters indicates whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity. (Page 384, Paragraph 1)
- b. Receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2)
- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3)
- d. Selecting in the computer system a bid from among the submitted bids. (Page 384, Paragraph 1)

- e. Identifying in the computer system an advertisement associated with the selected bid, whereby the identified advertisement is determined by a bidding process.

(Page 384, Paragraph 1)

Claim 114. Yager discloses a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, wherein the each advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system comprising of one or more networked computers which:
 - i. Maintains the plurality of advertisements and a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, whereby the each set of bidding parameters indicates whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity. (Page 383, Paragraph 2; Page 384, Paragraph 1; and Page 387, Paragraph 3)
 - ii. Receives an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2)

- iii. Submits in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3)
- v. Selects a bid from among the submitted bids. (Page 384, Paragraph 1)
- vi. Identifies an advertisement associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 226 and 227: Yager discloses the method of claims 62 and 114 respectively, wherein information about a viewer utilizing the browser is stored in the computer system. (Page 380, Paragraph 2)

Claim 166. Yager discloses a method implemented in a computer system comprising of one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising

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opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser, the method comprising:

- a. Receiving in the computer system an indication of the each advertising opportunity. (Page 383, Paragraph 2, and Page 384, Paragraph 1)
- b. In response to the indication: determining in the computer system one or more bids, each determined bid being associated with a monetary amount an advertiser associated with the each determined bid is willing to pay for the each determined bid is willing to pay for the each determined bid to be selected and a specific event to occur. (Page 383, Paragraph 2 through Paragraph 3)
- c. Selecting in the computer system a bid from among the determined bids. (Page 383, Paragraph 2 through Page 384, Paragraph 1)
- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process. (Page 384, Paragraph 1)

Claims 63, 115, and 167: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the monetary amount associated with each of the submitted bids is included in the each of the submitted bids. (Page 383, Paragraph 2 through Paragraph 3)

Claims 64, 116, and 168: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Page 383, Paragraph 2 through Paragraph 3)

Claim 65, 117, 169, 219, 228, 229, and 230: Yager discloses the method of claims 62, 114, 166, and 218, wherein the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3)

Claims 66, 118, and 170: Yager discloses the method of claims 65, 117, and 169 respectively, wherein the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3)

Claims 231 and 232: Yager discloses the method and system of claims 62 and 114 respectively, wherein at least one of the plurality of sets of bidding parameters

includes a plurality of levels, wherein a first level includes a first criteria of advertising opportunity and a second level includes the first criteria of advertising opportunities and a second criteria of advertising opportunities. (Page 385, Paragraph 1 through Page 386, Paragraph 2)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 67-113, 119-165, and 171-217 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183: Yager discloses the method of claims 62, 63, 64, 65, 66, 114, 115, 116, 117, 118, 166, 167, 168, 169, 170 respectively. Yager further discloses the user requesting content by the browser. (Page 383, Paragraph 6). Yager is silent with regard to the protocol used in transmitting the request from the browser, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to

use the standard HTTP protocol for communicating between the website and the browser as well as provide indications using said protocol. One would have been motivated to use the standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers.

Claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184: Yager discloses the method of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Page 384, Paragraph 1)

Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, and 185: Yager discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184 respectively, wherein the request for content by the browser is caused by a reference in the web page. (Page 384, Paragraph 1)

Claims 82-96, 134-148, 186-200, 220, and 222: Yager discloses the method of claims 67-81, 119-133, 171-185, 218, and 219 respectively, wherein the selection of the selected bid is based on the selected bid being associated with a highest monetary amount. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 97-111, 149-163, 201-215, 221 and 223: Yager discloses the method of claims 67-81, 119-133, 171-185, 218 and 219 respectively, wherein the selection of the selected bid is based on the selected bid being determined in a computer system as having a highest beneficial value over respective beneficial values of other submitted bids. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 112, 164, 216, and 224: Yager discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid is associated with a respective bidding agent. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

Claim 113, 165, 217 and 225: Yager discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

7. Claims 49, 50, and 62-232 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admissions regarding the combination of Dedrick (U.S. Patent Number: 5,724,521) in further view of Logan et al. (U.S. Patent Number: 5,721,827) in further view of Reilly (U.S. Patent Number: 5,740,549) in further view of Toland, Patrick ("CNET: The Computer Network Unveils Revolutionary Internet Advertising Tools That Allow Customer Banner Ad Delivery

Based on Demographic Information", PR Newswire, Dateline: San Francisco, Dec 6, 1995) in further view of Fujisaki (U.S. Patent Number: 4,789,928) or in further view of Murphy (U.S. Patent Number: 5,305,195)

Claims 49, 50, and 62-232: The admitted obvious combination of Dedrick, Logan, Reilly, Toland, Fujisaki, and Murphy (Admission found in Exhibit I, Roth preliminary Motion No. 2, Page 9, line 19 through Page 15, line 11, submitted by applicant in an IDS dated March 5, 2007)

Response to Arguments

8. Applicant's arguments filed December 4, 2007 have been fully considered but they are not persuasive.
 - a. The applicant argues that the "beneficial value" of each bid can generally correspond to the actual amount included in the bid and as such is entitled to the filing date of Patent Number 6,285,987. However, the term "beneficial value" has a scope that is broader than simply the actual amount and the scope of the term encompasses material not disclosed in Patent Number 6,285,987, such as effectiveness parameters.

Conclusion

9. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on March 5, 2007 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jvb
/J. V./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622